

REMARKS***Foreign Priority***

Applicants thank the Examiner for acknowledging the claim of foreign priority and receipt of the certified copy of the priority documents in the Office action of September 27, 2005.

Information Disclosure Statement

Applicants thank the Examiner for consideration of the Information Disclosure Statements filed April 19, 2004 and May 18, 2004, and return of the initialed Forms PTO-1449.

Applicants are concurrently submitting herewith, a Third Supplemental Information Disclosure Statement (IDS). Therefore, Applicants respectfully request that the Examiner consider the IDS and initial and return the Form PTO-1449 with the next communication to Applicants.

Summary of the Amendment

Upon entry of the foregoing amendment, claims 1 and 8 have been amended, claims 9-13 have been added, claims 2 and 3 have been cancelled, whereby claims 1 and 4-13 currently remain pending. Support for the amendment can be found in the originally filed specification and claims. No new matter has been added.

Response

In the instant Office Action, claim 8 has been rejected under 35 U.S.C. § 112, second paragraph as being unclear. In addition, claims 1-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,657,155 B2 (hereinafter, "ABE"). Claims 1-8 have further been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,682,684 B1 (hereinafter, "JAMALABAD"). Claims 1-8 have further been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-15 of ABE.

By the present amendment and remarks, Applicants submit that it is clear that the rejections should be withdrawn, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application. Specific arguments in response to each of the rejections recited in the Office action are set forth below.

1. The rejection of claim 8 under 35 U.S.C. § 112, second paragraph as being indefinite.

Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claim 8 as being indefinite in view of the following remarks.

Applicants have amended claim 8 to now recite "the sintered block where the excess portion is removed," which should remove any arguable basis for rejection under 35 U.S.C. § 112. Applicants respectfully submit that the

amendment to claim 8 to overcome the 35 U.S.C. § 112, second paragraph rejection does not affect the scope of the claim, but merely clarifies the claim in conformance with U.S. practice. Applicants have further amended the specification to remove references to the claims. No new matter has been added.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claim 8.

2. The rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over ABE.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a) of claims 1-8 as being unpatentable over ABE in view of the following remarks.

The present Application (No. 10/671,688) and U.S. Patent 6,657,155 B2 were, at the time the invention of Application No. 10/671,688 was made, owned by the same person, or subject to an obligation of assignment to the same person.

Therefore, pursuant to MPEP § 706.02(l), because the present application and U.S. Patent 6,657,155 B2 were, at the time the invention of Application No. 10/671,688 was made, owned by the same person, or subject to an obligation of assignment to the same person, ABE is not qualified as prior art against the

present claims. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-8 as being unpatentable over ABE.

3. The rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over LAMALABAD.

Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1-8 as being unpatentable over LAMALABAD in view of the following remarks.

It is well settled that in order to properly establish a *prima facie* case of obviousness, assuming, *arguendo*, that the rejection is based on a proper combination, the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicants respectfully submit that the obviousness rejection using the single reference of LAMALABAD still does not disclose all of the recitations of claims 1-8 especially in view of the presently amended claims. However, as will be shown below, even assuming, *arguendo*, that the application of LAMALABAD against the claims is proper, LAMALABAD still fails to establish a *prima facie* case of obviousness for at least the following reasons:

Applicants respectfully maintain that LAMALABAD does not teach or suggest each and every recited feature in the claims. Moreover, the motivation

set forth in the Office Action does not correct the deficiencies of LAMALABAD. The Office action admits that the LAMALABAD (incorrectly referred to as "Abe et al.") does not explicitly teach repeating the step of removing an excess portion. Applicants respectfully maintain that nothing in LAMALABAD would direct one of ordinary skill in the art to repeat the steps of forming a powder layer and irradiating the powder layer. The motivation set forth in the Office Action is clearly misplaced and cannot be gleaned from either LAMALABAD or one of ordinary skill in the art. Mere statements that it would have been obvious to one of ordinary skill in the art without pointing to support in the prior art is not sufficient to satisfy the *prima facie* case of obviousness.

Moreover, certain features of LAMALABAD teach away from the presently claimed invention. For example, the support structure 146 of LAMALABAD functions as a mold in manufacturing the object, whereby the support structure 146 is formed of a different material than that of the main structure. (see, e.g. col. 8, lines 31-44). Therefore, LAMALABAD fails to disclose that the excess portion is made of the same material and is removed repeatedly, thereby teaching away from the present invention.

Therefore, LAMALABAD fails to establish a *prima facie* case of obviousness as to why one would modify LAMALABAD to arrive at the present claims. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection of claims 1-8.

4. The rejection of claim 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-15 of ABE.

Applicants respectfully request withdrawal of the obviousness-type double patenting rejection of claims 1-8 in view of the following remarks.

As noted above, a proper *prima facie* case of obviousness requires that the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicants respectfully submit that the obviousness rejection using the single reference of ABE still does not disclose all of the recitations of claims 1-8 especially in view of the presently amended claims. However, as will be shown, even assuming, *arguendo*, that the obviousness-type double patenting rejection over ABE against the claims is proper, ABE still fails to establish a *prima facie* case of obviousness for at least the following reasons:

Initially, Applicants have amended, *inter alia*, independent claim 1 to add recitations of cancelled claim 2, wherein the sides of the sintered block include a concave portion “formed on a lower part of the sintered block.” Further, claim 9 has been added to include recitations of original claim 1 and cancelled claim 3, whereby claim 9 includes the recitation wherein the sides of the sintered block including a concave portion “wherein an upper surface of the concave portion is declined from the outside toward the inside.”

Applicants respectfully maintain that ABE does not claim the recitation in presently amended claim 1 wherein the sides of the sintered block include a concave portion "formed on a lower part of the sintered block," or the recitation in presently amended claim 9 wherein the sides of the sintered block including a concave portion "wherein an upper surface of the concave portion is declined from the outside toward the inside."

Moreover, the motivation set forth in the Office Action does not correct the deficiencies of ABE. The Office action admits that the ABE does not explicitly teach repeating the step of removing an excess portion. Applicants respectfully maintain that nothing in ABE would direct one of ordinary skill in the art to repeat the steps of forming a powder layer and irradiating the powder layer. Thus, the motivation set forth in the Office Action is clearly misplaced and cannot be gleaned from either ABE or one of ordinary skill in the art. Mere statements that it would have been obvious to one of ordinary skill in the art without pointing to support in the prior art is not sufficient to satisfy the *prima facie* case of obviousness.

Therefore, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection of claims 1-8.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§

102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

If for any reason the necessary fees are not associated with this file, the undersigned authorizes the charging of any necessary fees not explicitly identified, to Deposit Account No. 19-0089 in order to maintain pendency of this application.

CONCLUSION

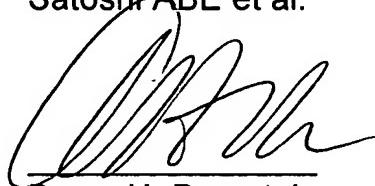
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicants' invention, as recited in each of claims 1 and 4-13. In addition, the applied documents of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
Satoshi ABE et al.



Bruce H. Bernstein
Reg. No. 29,027

Am. 33,094



December 23, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191